UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,566	12/12/2001	Naohiro Takemoto	033025-002	4857

21839 7590 11/03/2003

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER	
GUCKER, STEPHEN	

ART UNIT	PAPER NUMBER
1647	

DATE MAILED: 11/03/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/009,566	Takemoto et al.
Examiner	**Group Art Unit**
Stephen Gucker	1647

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on 6/30/03.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-3 + 22-49 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☑ Claim(s) 1-3 + 22-49 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachm nt(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing R view, PTO-948

☐ Other _____

Office Action Summary

Election/Restrictions

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1647.

2. This application was filed as a 35 USC 371 application: Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3 and 22-24, drawn to compounds and pharmaceutical compositions, wherein E2 is an oxygen.

Group II, claim(s) 25-39, drawn to methods of treatment using the products of Group I, wherein E2 is an oxygen.

Group III, claim(s) 1-3 and 22-24, drawn to compounds and pharmaceutical compositions, wherein E2 is a nitrogen.

Group IV, claim(s) 25-39, drawn to methods of treatment using the products of Group III, wherein E2 is nitrogen.

Group V, claim(s) 40-41, drawn to a method for selecting a neuroprotective compound by evaluating activation of receptors and phosphorylation of the FGF receptor by various kinds of

physiological substances, classified in class 435, subclass 7.2+ for example, but the actual classification will be dependent upon the chemical nature of the physiologically active substances.

Group VI, claim(s) 42, drawn to a method for selecting a neuroprotective compound by evaluating a neuroprotective effect against glutamate-induced neurodegeneration together with evaluating for antagonism against the neuroprotective effect of the physiologically active substance by treatment with MTA and by treatment with inhibitors of various physiologically active substance receptors, classification dependent upon the chemical nature of the inhibitors of the physiologically active substance receptors.

Group VII, claim(s) 42, drawn to a method for selecting a neuroprotective compound by evaluating a neuroprotective effect against glutamate-induced neurodegeneration together with evaluating the CalbindinD-28k inducing effect of the physiologically active substance, classification dependent upon the chemical nature of the physiologically active substance and the method used to detect the induction of CalbindinD-28k.

Group VIII, claim(s) 42, drawn to a method for selecting a neuroprotective compound by evaluating a neuroprotective effect against glutamate-induced neurodegeneration together with confirming that the neuroprotective effect of the physiologically active substance is due to its inducing CalbindinD-28k production, by treating with the antisense oligonucleotide of CalbindinD-28 and determining if CalbindinD-28k production is antagonized, classified in class 514, subclass 44+ for example, but the actual classification is dependent also upon the chemical

nature of the physiologically active substance and the method used to detect the induction of CalbindinD-28k production.

Claim 43 is dependent upon canceled claim 18, but it could belong to either Group VI or Group VII or Group VIII, depending upon how it is amended in accordance with the restriction requirement. (Claim 18 is similar in structure to claim 42, so claim 43 could be amended to belong to either Group VI or Group VII or Group VIII).

Group IX, claim(s) 44-45, drawn to compounds and compositions, classification dependent upon the chemical nature of the compounds and compositions.

Group X, claim(s) 46-49, drawn to methods of treatment using the compounds and compositions of Group IX, classified in class 514, subclass 824 for example, but the actual classification dependent upon the chemical nature of the compounds and compositions.

3. The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reason: the technical feature of Group I is not a contribution over the prior art as noted of record in Paper No. 9, filed 12/24/02, page 3. Because the technical feature of Group I is not novel, it cannot be a special technical feature. Because there is no special technical feature linking the Groups I-X, unity of invention is lacking.

4. The inventions are also distinct, each from the other because of the following reasons: A national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. If multiple products, processes of

manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application will be considered as the main invention in the claims, see PCT article 17(3)(a) and 1.476(c), 37 C.F.R. 1.475(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their separate classifications and because the literature searches required for the inventions are not co-extensive and therefore references that would anticipate one invention would not necessarily anticipate or even make obvious the other invention, a search burden exists, and restriction for examination purposes as indicated is proper. Furthermore, there are different issues for the search and examination of each, which would also be unduly burdensome.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found

allowable, withdrawn process claims that depend or otherwise include all the limitations of the allowable , withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP §821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "guidance on Treatment of Product and Process Claims in light of *In re Ochai, In re Brouwer* and 35 U.S.C. §103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so**

may result in a loss of the right to rejoinder.

Further, note the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues,. See MPEP §804.01.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (703) 308-6571. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is currently (703) 308-4242, but Applicant should confirm this by phoning the Examiner before faxing.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SG

Stephen Gucker

October 28, 2003

Gary L Kunz

GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600